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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,777	11/30/2001	Kazuhiko Morita	HOS-62	4620
7590	04/06/2004		EXAMINER	
Leonard W. Sherman Sherman & Shalloway 413 N. Washington Street Alexandria, VA 22314			VO, HAI	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Office Action Summary</b>	<b>Application No.</b> 09/996,777	<b>Applicant(s)</b> MORITA ET AL.	
	<b>Examiner</b> Hai Vo	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 15-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. The 112 claim rejections have been overcome by the present arguments (see page 5 of the 10/30/03 amendment).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao et al (US 5,492,741) substantially as set forth in the 12/15/03 amendment. With regard to newly added claims 27-29, it appears that the cushioning sheet of Akao is made of a polyolefin foam (column 3, lines 57-60) as recited in the claims, it is not seen that the polyolefin foam would have been performed differently from that of the present invention in terms of the ratio of insoluble components in boiling xylene. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Like foam material should have like properties.

The art rejections have been maintained for the following reasons. Applicants argues there would be no motivation to increase the thickness of the resin layer laminated onto the foam because such would destroy the cell structure on the surface part of the foam during the co-extrusion process, thereby reducing the density and strength of the laminated product. As recognized by

Applicant, the Akao invention is related to a hot-foaming method while the present invention is directed to a co-extrusion foaming process. It appears that the adhesive is used to laminate the resin layer onto the foam sheet after the foaming process. As pointed out by Applicant, an unfoamed sheet is created during the hot foaming method as described in the Akao invention. It is the examiner's position that since the foam cells are protected from the outside environment by the unfoamed sheet, it is not seen that any cell destruction would be resulted from increasing the thickness of the resin layer during the adhesive lamination as discussed by Applicant. Further, Applicant argues that the hot foaming process of the Akao invention is unrelated to the present invention. The arguments are not found persuasive because they are not commensurate with the scope of the claims. It is reminded that the claims are directed to a product and nothing specific about the process limitation is included in the claims. Finally, Applicant argues that Akao fails to teach each and every claimed limitation of the present invention. The examiner disagrees. Akao teaches a packaging material comprising a polyolefin foam layer 1 having a density of less than 0.5 g/cm<sup>3</sup> (abstract), a plurality of polyolefin layers 3a, 7a, 7a', 3a' laminated on at least one side of the polyolefin foam (figure 3). The outermost and innermost polyolefin layers 3a, 3a' have the same thickness of 25 microns and a melt flow rate of 5.0g/10min (column 47, lines 46 and 55). The packaging material has the foam density, the thickness of the outermost layer and the melt flow rate of the innermost layer meeting the specific ranges required by the

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claims. Akao fails to meet the thickness range of the innermost layer. However, since the thickness of the innermost layer is not critical to providing unexpected technical advantages, such a variable would have been recognized by one skilled in the art as dependent upon the intended use of the product. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the innermost layer 3a having a thickness instantly claimed motivated by the desire to improve the adhesion and strength of the laminate. This is in line with *In re Aller*, 105 USPQ 233 which holds that discovering the optimum or workable ranges involves only routine skill in the art.

4. Claims 15-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao et al (US 5,492,741) as applied to claim 1 above, further in view of Sheen et al (6,316,587) substantially as set forth in the 12/15/03 amendment. The same reasons as set forth in the paragraph above are believed to be pertinent. With regard to claims 17-20, Applicant argues that there is no connection between the description in Sheen et al and the present invention. The examiner disagrees. Akao discloses the packaging material comprising an antistatic agent in the outermost layer of the packaging material in an amount of 0.01 to 10 wt% (column 42, lines 1-4). Sheen, however, discloses an antistatic agent comprising a polyetheresteramide to impart the packaging material with antistatic properties. (column 1, lines 18-20 and column 4, lines 54 et seq.). This is important to the expectation of successfully practicing of the Akao invention, thus suggesting the

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modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the antistatic agent as taught in Sheen motivated by the desire to impart the packaging material with antistatic properties.

Akao does not specifically disclose how the polyetheresteramide is prepared. Sheen teaches that the polyetheresteramide is obtained by reacting of a polyamide with an alkylene oxide adduct of a bisphenol. Sheen does rectify the missing feature in the Akao invention. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the method of synthesizing the polyetheresteramide as taught in Sheen because such is a typical and practical process of making the antistatic agent.

With regard to claims 24-26, Akao teaches the packaging material comprising a foam sheet of closed-cell type having a thickness ranging from 100 microns to 5mm (column 3, lines 40-45). It appears that the total thickness of other layers in the packaging material is relatively thin to the thickness of the foam layer. It is the examiner's position that the thickness of the packaging material is the thickness of the foam sheet in the range of 100 microns to 5 mm, within the claimed range.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV



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